

A M E N D M E N T

Please amend the above-identified application as follows:

IN THE CLAIMS:

Please CANCEL Claims 193-194 without prejudice.

R E M A R K S

- Claims 177-189 and 193-195 were pending in the present application
- Claims 177-189 and 193-195 stand rejected

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 177-189 and 195 will be pending
- Claims 193-194 will be cancelled
- Claims 177-179, 185 and 195 will be the only independent claims

Telephone Interviews

Applicants would like to thank the Examiner for the helpful telephone conversations held on September 3-4, 2002, with Applicants' representative.

The Examiner stated that the Affidavit filed by Applicants on January 4, 2002, overcomes the Nielsen reference. It is Applicants' understanding, therefore, that any rejections relying on the Nielsen reference, including the Section 103(a) rejection of Claims 177-189 and 193-195 over Nielsen in view of Harte (Office Action mailed June 19, 2001, Paper No. 26), have been or will be withdrawn by the Examiner.

The Examiner stated that one rejection of Claims 177-178 asserted in Section 12.A of the present Office Action (Paper No. 31) is based solely on the Examiner's Official Notice of "the steps of 'expert matching' e.g. the USPTO Commissioner...." The Examiner also confirmed that the rejection is a Section 103(a) rejection.

The Examiner confirmed that Claims 177-189 and 193-195 are rejected in the present Office Action (Paper No. 31) under Section 103(a) over Canale in view of Harte.

The Examiner and Applicants' representative also agreed that Claim 195 is not obvious in light of Canale and Harte alone. For example, neither Canale nor Harte, alone or in combination, teaches or suggests either (i) *receiving at least one bid on the end user request from the at least one expert*, or (ii) *transmitting the at least one bid to the end user*.

The Examiner and Applicants' representative discussed the Examiner's statements with respect to "Yellow Pages" in Sections 3, 3.F, and 12.B. The Examiner stated that no claims are currently rejected in light of any "Yellow Pages" reference, alone or in combination.

The Examiner and Applicants' representative agreed that any future reliance on an asserted "Yellow Pages" reference as the basis for a rejection would constitute new grounds for rejection.

While no formal agreement as to patentability was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claim Amendments

Claims 193-194 have been cancelled without prejudice

Claims 193-194 have been cancelled without prejudice solely to expedite prosecution of the pending claims. Applicants plan to pursue the subject matter of Claims 193-194 in a continuing application.

Section 103(a) Rejection

I. Rejection of Claims 177-189 and 193-195 over Canale in view of Harte

The Examiner asserts that Claims 177-189 and 193-195 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Canale et al. (US Pat. 5,619,648) [hereinafter "Canale"], in view of Harte (US Pat. 4,576,579)" [hereinafter "Harte"]. Office Action, Section 12.

Applicants respectfully traverse the Examiner's Section 103(a) rejection of Claims 177-189 and 193-195 over Canale in view of Harte.

A. Claims 177-189

Applicants respectfully submit that independent Claims 177-179 and 185 are not obvious in light of Canale or Harte, either alone or in combination. Neither Canale nor Harte, either alone or in combination, teaches or suggests all of the features of independent Claims 177-179 and 185. Also, there is no suggestion or motivation to modify or to combine the cited references to provide the claimed features. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claims 177-179 and 185. Applicants respectfully request allowance of independent Claim 177-179 and 185.

i. Canale and Harte do not suggest all of the features of any of independent Claims 177-179 and 185

Each of independent Claims 177-178 and 185 is directed to a "computer implemented expert matching method for managing communications between an expert and an end user," and each recites features directed to:

- *receiving a first expert qualification corresponding to a first expert*
- *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification*
- *transmitting the first expert qualification to the second expert*
- *receiving a signal from the second expert that indicates approval of the first expert qualification*

In explaining the rejection of Claims 177-189 over Canale in view of Harte, the Examiner asserts: "The limitations of these claims recite the same claim limitations as claims 193-195 discussed above." Office Action, Section 12.C. Applicants respectfully traverse the Examiner's assertion that Claims 177-189 recite the "same claim limitations" as Claims 193-195. For example, none of the above features are recited in any of Claims 193-195.

Independent Claims 177-178 and 185 are submitted as being patentable in light of Canale in view of Harte alone, at least because of the recitation of features directed to (i) *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification*, (ii) *transmitting the first expert qualification to the second expert*, or (iii) *receiving a signal from the second expert that indicates approval of the first expert qualification*. These features are not taught or suggested by Canale in view of Harte alone, as relied upon by the Examiner.

Applicants respectfully submit that Canale does not teach or suggest any of the above features; the Examiner does not assert otherwise.

The Examiner asserts that Harte has “implicit suggestions” of:

- (i) a controller unit for receiving a request to grade a multiple choice test...
- (ii) [the controller unit defining] a testing level and
- (iii) [the controller unit] selecting an appropriate test level questions (a requested expert qualification),
- (iv) this controller unit (computer using for testing) having a database for storing a plurality of test levels/(expert qualifications),
- (v) each stored level/(different expert qualification) corresponding to an appropriate test/(expert of a plurality of sub-level experts),
- (vi) each stored test answer template/(expert qualification) being associated with an address stored in the database and corresponding to a test/an expert...

- (vii) - means for selecting/searching the database to identify a test/expert corresponding to the requested test/qualification...[;]
- (viii) - means for requesting management's approval of a specific test (a standard of qualification) to a corresponding level of grade; and
- (ix) means to receive a response on that matter (this is analogous to ‘receiving a ‘signal’ from the second expert (e.g. from manager) that indicates approval of the first expert qualification (a specific test)’

Office Action, Section 12.B (notation added and emphasis removed). Applicants respectfully traverse these assertions.

Contrary to the Examiner’s assertions as to what Harte “implicitly suggests,” Harte does not teach or suggest a test level, much less a controller unit that defines a testing level, approves a test level, or selects an appropriate test level question. Harte is directed specifically to an apparatus using elastic and electroconductive sheets. The physical sheets define questions and response areas representing correct and incorrect answers; the described computer receives indications of correct and incorrect responses based on manipulations of the sheets with a stylus. See, Column 1; Columns 3-4. The described computer thus does not suggest test levels, storing test levels, selecting test levels, storing tests, selecting tests, storing questions, or selecting questions.

Accordingly, there is nothing in Harte that would suggest any of the features of the controller unit as relied upon by the Examiner. For instance, Harte clearly teaches away from a controller unit for selecting an appropriate question, for selecting a test level, or for storing test answer templates.

There is also nothing in Harte that would suggest any of the above “means” asserted and relied upon by the Examiner. For instance, Harte clearly teaches away from searching a database to identify a test. Further, there is nothing in Harte that would suggest an “expert” or

"management," much less requesting approval from management of a specific test, much less receiving a response indicating approval of a specific test.

Even if Harte taught or suggested the subject matter asserted by the Examiner, which Applicants dispute, that would not suggest the subject matter claimed. For instance, there is nothing in either Canale or Harte that would suggest that approving the administration of a particular test suggests approval of an expert qualification, much less any of (i) *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification*, (ii) *transmitting the first expert qualification to the second expert*, or (iii) *receiving a signal from the second expert that indicates approval of the first expert qualification*, as recited in each of independent Claims **177-178 and 185**.

At Section 3.F of the present Office Action, the Examiner states the above features "lack of inventive steps...." Even if the above features "lack of inventive steps," which Applicants respectfully dispute, Applicants are not aware of any statutory requirement that a feature be an "inventive step." Accordingly, Applicants respectfully traverse the Examiner's assertion. Applicants respectfully submit that independent Claims **177-178 and 185** comply with all statutory requirements for patentability.

Claim **179** recites a step of *receiving a signal from the set of experts that indicates approval of the first expert qualification*. Accordingly, Applicants respectfully submit that independent Claim **179** is patentable in light of Canale in view of Harte alone for at least the reasons stated above with respect to independent Claims **177-178 and 185**.

In addition, the Examiner does not assert that the Officially-Noticed procedure teaches or suggests a feature of *incorporating identity data of the second expert into a key of the first expert*, as recited in independent Claim **178**. Applicants respectfully submit that the asserted procedure does not teach or suggest such a feature. Accordingly, Applicants respectfully submit that independent Claim **178** contains patentable subject matter in light of Canale in view of Harte alone.

Accordingly, Applicants respectfully submit that independent Claims **177-179 and 185** contain allowable subject matter.

Dependent Claims **180-184 and 186-189** are submitted as containing patentable subject matter for at least the reasons stated above with respect to independent Claims **177-179 and 185**.

Further, Applicants respectfully submit that neither Canale nor Harte teaches or suggests any of the features of:

- *guaranteeing payment to the first expert*

as recited in each of Claims **180 and 186**;

- *requiring the end user to prepay*

as recited in each of Claims **181 and 187**;

- *checking a credit card account*

as recited in each of Claims **182 and 188**;

- *wherein said checking a credit card account is performed before said transmitting at least a portion of the end user request to the first expert*

as recited in each of Claims 183 and 189; or

- *establishing a price for the expert answer corresponding to the end user request*
- *if credit available on the credit card account is less than the price of the expert answer, requesting that the end user provide a credit card number of another credit card account*

as recited in Claim 184.

Applicants respectfully submit that Canale does not teach or suggest any of the above features; the Examiner does not assert otherwise.

The Examiner asserts that Harte implicitly suggests “means for guaranteeing payment to the selected test.” Office Action, Section 12.B. Applicants respectfully traverse this assertion. As discussed above, there is nothing in Harte that would suggest a test that is selected.

Applicants respectfully submit that there is nothing in Harte that would suggest a payment or a “test fee,” as relied upon by the Examiner. Accordingly, Applicants respectfully submit that Harte is devoid of a hint or suggestion of payment to a selected test, much less guaranteeing any such payment.

Also, even if Harte suggests such subject matter, which Applicants dispute, it would not suggest the feature of *guaranteeing payment to the first expert*, as recited in each of Claims 180 and 186. Specifically, there is nothing in the prior art to suggest that a test suggests an expert, as relied upon by the Examiner.

Applicants respectfully submit that Harte does not teach or suggest any of the other features of Claims 181-184 and 187-189 listed above; the Examiner does not assert otherwise.

ii. No motivation to combine Canale and Harte

There is no suggestion or motivation, in either (i) the Canale and Harte references, (ii) the knowledge generally available to one of ordinary skill in the art, or (iii) the problem to be solved, to modify or to combine the Canale and Harte references to provide for all of the features of Claims 177-189.

With respect to Claims 177-189 and 193-195, at Section 12.B of the present Office Action, the Examiner states: “One of ordinary skills in the art at the time of the invention would have found these claims’ limitations would be very obvious...because these prior arts are also directed to a similar process for obtaining job applications from remotely located applicants.” Applicants respectfully traverse this assertion.

Neither Canale nor Harte is directed to “jobs,” much less obtaining job applications from job applicants. Applicants believe that this proposed motivation was previously asserted with respect to the Nielsen reference (see Office Action mailed June 19, 2001, Section 15.B), and inadvertently remains in the present Office Action. Applicants respectfully request that the Examiner reconsider this asserted motivation.

As discussed above, contrary to the Examiner’s assertion, Harte does not teach or suggest a test level, much less a controller unit that either defines a testing level or selects an appropriate test level question. Accordingly, there is nothing in Harte that would suggest any of the features of the controller unit asserted by the Examiner. For instance, Harte clearly teaches away from a controller unit for selecting an appropriate question, for selecting a test level, or for storing test answer templates.

Nonetheless, with respect to Claims 177-189 and 193-195 the Examiner states:

It would have been obvious...to implement the same concept of testing a level/(an achievement) to perform functions as claimed; because all cited references would suggest using a similar means and applying a similar concept as a [sic] expert matching computer to select an appropriate source for a specific solution. A motivation for 'bidding an expert'/essentially bidding for an expert's SKILL' is to gain potentially capable people for a specific purpose; that is what has been widely applied (in 'head hunting' recruitments) since the past.

Office Action, Section 12.B. Applicants respectfully traverse this assertion.

Applicants respectfully submit that Canale is devoid of a hint or suggestion of either "testing," "a level," or "an achievement." The Examiner does not assert otherwise. As discussed above, Harte is also devoid of a hint or suggestion of a "test level," testing a "level," or an "achievement." s

As discussed with the Examiner, both Canale and Harte are devoid of a hint or suggestion of "bidding an expert." Harte, being concerned with an instructional and testing device, has nothing to do with the mail filter described in Canale. Further, Harte, being concerned with an instructional and testing device, has nothing to do with the claimed subject matter of a computer implemented expert matching method. Harte also is devoid of a hint or suggestion of the motivation, as asserted and relied upon by the Examiner, of "gain[ing] potentially capable people for a specific purpose" or "head hunting."

Accordingly, Applicants respectfully submit that there is nothing in the prior art of record that suggests the desirability of combining Canale and Harte as proposed by the Examiner.

B. Claim 195

Independent Claim 195 is directed to a "computer implemented expert matching method for managing communications between an expert and an end user". The claimed method includes features directed to:

- receiving an end user request from the end user
- transmitting the end user request to at least one expert
- receiving at least one bid on the end user request from the at least one expert
- transmitting the at least one bid to the end user
- allowing the end user to select an expert who corresponds to a transmitted bid
- notifying the selected expert of acceptance of the selected expert's bid
- receiving from the selected expert an expert answer responsive to the end user request
- transmitting the expert answer to the end user

Applicants respectfully submit that independent Claim 195 is not obvious in light of Canale or Harte, either alone or in combination. Neither Canale nor Harte, either alone or in combination, teaches or suggests all of the features of independent Claim 195. Also, there is no suggestion or motivation to modify or to combine the cited references to provide the claimed features. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 195. Applicants respectfully request allowance of independent Claim 195.

i. Canale and Harte do not suggest all of the features of independent Claim 195

As discussed during the Telephone Interview, the Examiner and Applicants agree that neither the Canale reference nor the Harte reference, alone or in combination, teaches or suggests features generally directed to receiving a bid on an end user request from an expert.

Accordingly, independent Claim 195 is submitted as being patentable over the asserted combination of Canale and Harte alone by virtue of at least its recitation of (i) *receiving at least one bid on the end user request from the at least one expert*, (ii) *transmitting the at least one bid to the end user*, (iii) *allowing the end user to select an expert who corresponds to a transmitted bid*, and (iv) *notifying the selected expert of acceptance of the selected expert's bid*.

ii. No motivation to combine Canale and Harte

There is no suggestion or motivation, in either (i) the Canale and Harte references, (ii) the knowledge generally available to one of ordinary skill in the art, or (iii) the problem to be solved, to modify or to combine the Canale and Harte references to provide for all of the claimed features of independent Claim 195.

For at least the reasons stated above with respect to Claims 177-189, Applicants respectfully submit that there is no motivation to combine Canale and Harte to provide for all of the features of independent Claims 195.

iii. "eBay.com"

The Examiner asserts that purported "bidding ideas" of "eBay.com" teach the features of (i) *receiving at least one bid on the end user request from the at least one expert*, (ii) *transmitting the at least one bid to the end user*, (iii) *allowing the end user to select an expert who corresponds to a transmitted bid*, and (iv) *notifying the selected expert of acceptance of the selected expert's bid*, "although [at eBay.com] only 'objects' are used for this purpose." Office Action, Section 3.C, 4 (emphasis added). Applicants respectfully traverse this assertion.

Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the brief reference to "bidding ideas" of "eBay.com," Applicants cannot properly determine the bounds of the asserted reference. Accordingly, Applicants dispute that the subject matter asserted was "well known" at the time the invention was made, and request a reference to clarify the subject matter in more detail. MPEP 2144.03.

Applicants also respectfully submit that the Examiner has not provided a reasoned explanation of how the prior art of record suggests that asserted "bidding ideas" related to "objects" suggest a bid on an end user request from at least one expert. Applicants respectfully submit that they do not. In fact, the Examiner specifically states that the asserted "bidding ideas" are used only for "objects."

Further, Claim 195 recites a feature of *receiving at least one bid on the end user request from the at least one expert* (emphasis added). Thus, even if the asserted "eBay.com" does teach or suggest *bidding for an expert's skill*, which Applicants dispute, this would not teach or suggest a feature generally directed to receiving a bid from at least one expert.

At Section 3.F of the present Office Action, the Examiner states the feature of (i) *receiving at least one bid on the end user request from the at least one expert* and (ii) *transmitting the at least one bid to the end user* "lack of inventive steps..." Even if the above features "lack of inventive steps," which Applicants respectfully dispute, Applicants are not aware of any statutory requirement that a feature be an "inventive step." Accordingly,

Applicants respectfully traverse the Examiner's assertion. Applicants respectfully submit that Claim 195 complies with all statutory requirements for patentability.

iv. No motivation to combine Canale, Harte and "eBay.com"

The Examiner also asserts:

A motivation for 'bidding an expert'/'essentially bidding for an expert's SKILL' is to gain potentially capable people for a specific purpose; that is what has been widely applied (e.g., in 'head hunting' or bidding a defense contract (opinions are given from a variety of sources; 2nd sources/experts are among those contributing opinions) to select from any different bids) in the past.

Office Action, Section 4. Applicants respectfully traverse this assertion.

The Examiner has not provided a reasoned explanation as to how the asserted "eBay.com" reference teaches or suggests "bidding for an expert or an expert's skill." In fact, the Examiner specifically states that bidding at "eBay.com" is only for "objects."

Given that the only particular information in the record thus far regarding the Examiner's asserted motivation to combine Canale, Harte, and "eBay.com," are the brief references to "head hunting" and "bidding a defense contract," Applicants cannot properly determine either the bounds of the prior art or the source of the motivation. Accordingly, Applicants dispute both (i) that the subject matter asserted was "well known" at the time the invention was made, and (ii) that such subject matter, if found in the prior art, would suggest the desirability of modifying the asserted combination of Canale and Harte to provide for a feature of *receiving at least one bid on the end user request from the at least one expert*, as recited in independent Claims 195. Applicants respectfully request a reference to clarify the asserted subject matter and asserted suggestion of desirability in more detail. MPEP 2144.03.

The Examiner has failed to establish a motivation or suggestion of the desirability of combining Canale, Harte, and the asserted "eBay.com" to provide for all of the features of independent Claim 195. Accordingly, Applicants respectfully submit that independent Claim 195 is patentable in light of any proposed combination of Canale, Harte, and the asserted "bidding ideas" of "eBay.com."

C. Claims 193-194

Applicants respectfully traverse the Examiner's Section 103(a) rejection of Claims 193-194. Claims 193-194, however, have been cancelled without prejudice. Accordingly, the Section 103(a) rejection of Claims 193-194 is moot. Applicants plan to file claims directed to the subject matter of Claims 193-194 in a continuing application.

II. Rejection of Claims 177-178 over "steps of 'expert matching'"

The Examiner asserts that "Claims 177-178 are rejected because they 'read-on' the steps of 'expert matching'" purportedly practiced in the United States Patent and Trademark Office. Office Action, Section 12.A.

The Examiner stated during the Telephone Interview that the rejection of Claims 177-178 asserted in Section 12.A of the present Office Action (Paper No. 31) is based solely on the Examiner's Official Notice of "the steps of 'expert matching' e.g. the USPTO Commissioner...."

The Examiner also confirmed that the rejection is a Section 103(a) rejection.

Applicants respectfully traverse the Examiner's Section 103(a) rejection of Claims 177-178 solely in light of an Officially-Noticed procedure.

A. Improper use of "Official Notice" as sole evidence for rejection

Claims 177-178 are rejected solely in light of an Officially-Noticed "steps of 'expert matching'" purportedly practiced in the USPTO. Although Applicants have made requests in the past (Response mailed April 6, 2001), the Examiner has not yet provided documentary evidence in support of the Official Notice of the asserted USPTO practice. Accordingly, Applicants respectfully submit that the Section 103(a) rejection of Claim 177-178 via Official Notice alone is an improper use of Official Notice.

"The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP 2144.03. However, "the facts so noticed serve to 'fill in the gaps' which might exist in the evidentiary showing" and should not comprise the principle evidence upon which a rejection is based. MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091) (emphasis added).

Applicants respectfully submit that (i) Officially-Noticed facts should not be the principal evidence upon which a rejection is based; (ii) it is never appropriate to rely solely on 'basic knowledge' in the art or 'common sense,' without evidentiary support in the record, as the basis for core factual findings underlying a patentability rejection; and (iii) findings of 'basic knowledge' or 'common sense' in the art may only be used to support peripheral issues. See, "Administrative Notice Guidelines," Anton Fetting, Legal Advisor, Office of Patent Legal Administration, U.S. Patent and Trademark Office, page 6 (copy attached).

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of Claim 177-178 in light of the Officially-Noticed "steps of 'expert matching'".

B. Traverse of Official Notice of asserted "steps of 'expert matching'"

With respect to various recited features of Claims 177-178, the Examiner states: "[T]hese kinds of actions have been widely used in many areas (USPTO might not expressly say that limitation [sic] exactly as claimed languages [sic], neither published those ideas, but in its telephone directory, as an example, clearly showing a hierarchical order that reflecting [sic] above limitations...." Section 3.B (emphasis in original). The Examiner further states: "This has widely used/been available in public knowledge; this idea of doing business from USPTO would be implemented in cited references by one or ordinary skills in the art, it comprises hierarchical authorities." Section 3.B

The Examiner thus appears to be relying on what is purportedly "reflected" in an asserted telephone directory and what is purportedly "public knowledge." Given that the asserted USPTO practice is not published, and that the only particular information in the record thus far regarding what is considered to be in the prior art is the brief statement of the existence of a telephone directory that purportedly "reflects" all of the features of Claims 177-178, Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants dispute that the subject matter asserted was "well known" at the time the invention was made, and request a reference to clarify the subject matter in more detail. MPEP 2144.03.

C. The Officially-Noticed procedure does not teach or suggest all of the features of independent Claims 177-178

Even if the sole use of the Officially-Noticed procedure without any documentary evidence is proper, which Applicants dispute, Applicants respectfully submit that Claims 177-178 are not obvious in light of the asserted “business method.”

Each of independent Claims 177-178 is directed to a “computer implemented expert matching method for managing communications between an expert and an end user,” and each recites features directed to:

- *receiving a first expert qualification corresponding to a first expert*
- *selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification*
- *transmitting the first expert qualification to the second expert*
- *receiving a signal from the second expert that indicates approval of the first expert qualification*

Thus, an expert to be matched with an end user has his or her qualifications approved by a second expert. This helps to assure than an expert provided for communication with an end user is appropriately qualified.

In explaining the rejection of Claims 177-178, the Examiner asserts that it “reads on” a procedure carried out in the USPTO whereby a patent examiner is assigned to examine a particular patent application. Office Action, Section 12.A. The patent examiner has a supervisor, who “is the right one to give a second/first opinion about a claimed limitation....” Office Action, Section 3.B. The Examiner states: “USPTO’s method of doing business would be related to ‘expert qualification’ comprising a first expert (examiner) and a second expert having authority to approve the first expert ‘qualification’ (his supervisor).” Upon making decision [sic] about a consulted matter, a ‘YES’ or ‘NO’ answer has been given (...equivalent to a communicating ‘signal’).” Office Action, Section 3.B.

Applicants find it very doubtful that the asserted USPTO procedures for assigning a patent examiner to examine a particular patent application are pertinent to the claimed computer implemented expert matching system.

Nevertheless, it is assumed for the sake of argument that a patent examiner can be considered an “expert” and an applicant’s attorney can be considered an “end user” as those terms are used in Claims 177-178. Even so, nothing in the asserted USPTO procedure entails the claimed steps of *receiving a first expert qualification corresponding to a first expert*, nor *transmitting the first expert qualification to a second expert*, nor *receiving a signal from a second expert that indicates approval of the first expert qualification*.

Specifically, the asserted “consulted matter” does not teach or suggest a qualification corresponding to an expert, much less either receiving, transmitting, or approval of such a qualification. In fact, the Examiner states that the approval communicated by the supervisor in the asserted procedure is with respect to a matter on which the patent examiner is consulting the supervisor. In the asserted USPTO practice, a supervisor gives a “YES” or “NO” answer to a patent examiner in regard to “a consulted matter” such as an opinion about a claimed limitation. There is nothing in this asserted procedure to suggest that the supervisor is receiving a qualification corresponding to the patent examiner, much less that the supervisor’s “YES” or “NO” answer is an approval of any qualification corresponding to the patent examiner.

Thus, Claims 177-178 are submitted as being patentable in light of the Examiner's Official Notice alone, at least because of the recitation of a feature of *receiving a signal from the second expert that indicates approval of the first expert qualification*, since this step is not taught or suggested by Official Notice alone, as relied upon by the Examiner.

At Section 3.F of the present Office Action, the Examiner states the above feature "lack[s] of inventive steps...." Even if the above feature "lack[s] of inventive steps," which Applicants respectfully dispute, Applicants are not aware of any statutory requirement that a feature be an "inventive step." Accordingly, Applicants respectfully traverse the Examiner's assertion. Applicants respectfully submit that Claims 177-178 comply with all statutory requirements for patentability.

III. "Yellow Pages"

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to any claim in light of asserted "Yellow Pages."

The Examiner stated during the Telephone Interview that no claims are currently rejected in light of "Yellow Pages." The Examiner and Applicants' representative agreed that any future reliance on the asserted "look[ing] at the Yellow Pages to search for a specific expert" as the basis for a rejection would thus constitute a new grounds for rejection.

Given that the only particular information in the record thus far regarding the asserted "Yellow Pages" search is a brief statement at Section 3.B, Applicants cannot properly determine the bounds of this asserted prior art. If the Examiner asserts "Yellow Pages" as new grounds for rejection in a subsequent Office Action, Applicants respectfully request a reference to clarify any asserted subject matter in more detail. MPEP 2144.03.

Applicants respectfully submit that Claims 177-189 and 193-195 are allowable.

Applicants' Affidavit

The Examiner states in the present Office Action: “[T]he evidence in [the Affidavit]...is very abstractive and it was not sufficient for the reason of ‘reduction to practice’ with that submitted evidence (just 2-3 lines !!! it really was an incomplete invention).” Section 3 (emphasis in original). Applicants respectfully disagree.

Applicants respectfully submit that the showing of facts is of sufficient character and weight to establish (i) Applicants’ conception of the claimed subject matter prior to the effective date (February 27, 1996) of the Nielsen reference, and (ii) Applicants’ due diligence from prior to said effective date to a subsequent reduction to practice or to the filing of the application, in accordance with CFR § 1.131.

During the Telephone Interview, however, the Examiner stated that the Affidavit filed by Applicants on January 4, 2002, overcomes the Nielsen reference. It is Applicants’ understanding, therefore, that any rejections relying on the Nielsen reference, including the Section 103(a) rejection of Claims **177-189 and 193-195** over Nielsen in view of Harte (Office Action mailed June 19, 2001, Paper No. 26), have been or will be withdrawn by the Examiner.

Applicants are grateful for the Examiner’s acceptance of the Affidavit and the Examiner’s withdrawal of any rejections relying on Nielsen.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a THREE-month extension of time with which to respond to the Office Action. Please charge \$460.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Michael Downs
Attorney for Applicants
Walker Digital LLC
Registration No. 50,252
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax

October 1, 2002
Date